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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/785,262	02/24/2004	Yoichi Morimoto	FUJO 20.967	8916

26304 7590 05/19/2006

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EXAMINER

IWUCHUKWU, EMEKA DERRICK

ART UNIT	PAPER NUMBER
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2617

DATE MAILED: 05/19/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/785,262	Applicant(s) MORIMOTO, YOICHI	
	Examiner Emeka D. Iwuchukwu	Art Unit 2617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-12 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-12 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. The Art Unit location of your application in the USPTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to Art Unit 2617.

Response to Amendment

2. This Office Action is in response to the amendment filed on 05/04/2006.

Specification

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1,2,5-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Bach et al. U.S. Patent No. 6,377,795 (*hereinafter Bach*).

With respect to claims 1,2,9&10, Bach teaches a portable terminal device (Col 1 Line 63) and a method for preventing one-time only calls to a portable telephone set, comprising: a determination unit retrieving data from a telephone directory database if a call arrives at a portable terminal device, and determining whether an originating number is registered in a telephone directory database (Col 2 Lines 26-33); and a transmitting unit immediately connecting the call if the originating number is registered in the telephone directory database

(Col 2 Lines 43-46), and connecting the call immediately if the originating number is for a call set to a zero-calling time (Col 2 Lines 43-46; Col 6 Line 11), and announcing a recorded message (Col 2 Lines 54-58) to the originator.

With respect to claims 5&6, Bach teaches the portable terminal device according to claims 1&2, wherein after the recorded message is announced to the originator, a message from the originator is recorded (Col 2 Line 65-Col 3 Line 11).

With respect to claims 7&8, Bach teaches the portable terminal device according to claims 1&2 respectively, wherein the connection is made before a calling tone is generated (Col 2 Lines 43-46; Col 6 Line 11).

Claim Rejections - 35 USC § 103

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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8. **Claims 3&4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bach et al. U.S. Patent No. 6,377,795 (*hereinafter Bach*) in view of Cannon et al. U.S. Patent No. 6,026,152 (*hereinafter Cannon*).

Bach teaches the portable terminal device according to claims 1&2. Bach fails to expressly disclose the zero-calling time setting is made in a recorded message response time area of the telephone directory database.

In the same field of endeavor, Cannon teaches a similar device wherein the zero-calling time setting is made in a recorded message response time area of the telephone directory database (Col 2 Lines 35-41; Col 3 Lines 49-50).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to make the zero-calling time setting in a recorded message response time area of the telephone directory database, so the setting can be directly associated with the different numbers in the database.

9. **Claims 11&12** are rejected under 35 U.S.C. 103(a) as being unpatentable over Bach et al. U.S. Patent No. 6,377,795 (*hereinafter Bach*) in view of Davidson et al. U.S. Patent Publication 2002/0085690 A1 (*hereinafter Davidson*).

Bach teaches retrieving data from a telephone directory database if a call arrives at a portable terminal device, and determining whether an originating number is registered in a telephone directory database (Col 2 Lines 26-33); and immediately connecting the call if the originating number is registered in the telephone directory database (Col 2 Lines 43-46), and connecting the call immediately if the originating number is for a call set to a zero-calling time (Col 2 Lines 43-46; Col 6 Line 11), and announcing a recorded message (Col 2 Lines 54-58)

wherein a message from the originator is recorded in a processing device of the portable telephone set (Col 1 Lines 22-24; Col 3 Lines 19-26,59-60). Bach fails to expressly disclose that the process is on a computer readable medium.

In the same field of endeavor, Davidson teaches a similar process stored on a computer readable medium (paragraph 17, Claim 21).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include the option of storing the process on a computer-readable medium so it can be executed at different locations.

Response to Arguments

10. Applicant's arguments filed 05/04/06 have been fully considered but they are not persuasive.

In response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., Bach does not cause a caller to incur a telephone charge) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after

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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emeka D. Iwuchukwu whose telephone number is (571) 272-5512. The examiner can normally be reached on M-F (9AM - 5.30PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Duc Nguyen can be reached on (571) 272-7503. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

EDI


ELISEO RAMOS-FELICIANO
PRIMARY EXAMINER